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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|---|-------------|----------------------|-------------------------------|------------------------|
| 10/791,688  | 03/01/2004  | Jeffrey Bergh        | HARD1.072A                    | 2600                   |
| 60148 7590 05/09/2007<br>GARDERE / JAMES HARDIE<br>GARDERE WYNNE SEWELL, LLP<br>1601 ELM STREET<br>SUITE 3000<br>DALLAS, TX 75201 |             |                      | EXAMINER<br>KENNEDY, JOSHUA T |                        |
|   |             |                      | ART UNIT<br>3679              | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/791,688

Applicant(s)

BERGH ET AL.

Examiner

Joshua T. Kennedy

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*JK*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15,25-27,29-37,39-45 and 68-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,25-27,29-37,39-45 and 68-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/2007 has been entered.

Claims 1-7, 9-15, 25-27, 29-37, 39-45, and 68-78 have been examined.

Claims 8, 16-24, 28, 38, and 46-67 have been cancelled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-15, 25-27, 29-37, 39-45, and 68-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caceres et al in view of Gleeson et al (US Patent Application Publication 2001/0047741).

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As to Claims 1-5, 9-12, 15, 25, 26, 31, 34-36, 42, 68-70, 72, and 75. Caceres et al

disclose a fence system, comprising:

a horizontal mounting surface (15); and

a plurality of individual elongate members or pickets (13) attached to the horizontal mounting surface, wherein each individual member has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the plurality of individual members are made into a desired shape for use in the fence system prior to curing (Col 3, Lines 29-35) and wherein the front surface and back surface of the individual members are embossed with a pattern thereon resembling a wooden picket (Col 3, Lines 29-36), and the upper end of the plurality of individual members being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1—Shows the pickets with a dog-eared shape), and

said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1).

Caceres et al do not disclose the plurality of individual members being made of a plurality of layers of fiber cement whereby the plurality of individual members do not exhibit any substantial visible separation or fraying of the fibers along surfaces of the plurality of individual members after curing, wherein the fiber cement forming the plurality of individual members incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

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Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the plurality of individual members as taught by Caceres to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

It is also noted that the limitations of "the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" and "the fiber cement members are cut to size and shaped" impart limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed or how the members are sized and shaped when all features and structure are present. See MPEP § 2113.

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As to Claims 6, 7, 18, 27, 29, 30, 32 and 76-78. Caceres et al disclose the front surface and back surface of at least one individual member having a first surface, wherein the first surface has a finish that is has a pattern resembling wood and the color thereof or masonry (Col 3, Lines 29-36).

As to Claims 13, 14, 43, and 44. Caceres et al disclose the horizontal mounting surface comprising a pair of mounting rails (15) having a longitudinal axis, and the at least one individual member is positioned in a manner such that a longitudinal axis of the individual members (or pickets) is substantially perpendicular to the longitudinal axis of the horizontal mounting surface, wherein a first mounting rail is secured to the pickets at an upper location of the pickets, and a second mounting rail is secured to the pickets along a lower location of the pickets (Fig 1).

As to Claim 33. Caceres et al disclose the picket capable of being nailed onto a fence rail (Col 2, Lines 19-22).

As to Claims 34 and 37. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has an aspect ratio of between 4 and 12 and is spaced from one another by a distance of between about 1/2 and 1 inch. However, it is stated that "the slats may be spaced such that there is visibility between each slat (Col 2, Lines 5-7) and it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been

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obvious to one of ordinary skill in the art to dimension each of said pickets to have an aspect ratio of between 4 and 12 and be spaced from one another by a distance of between about 1/2 and 1 inch so as to achieve the desired aesthetic appearance.

As to Claims 39, 71, and 73. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a length between about 6 and 8 feet. However it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a length between about 6 and 8 feet so as to achieve the desired functionality and aesthetic appearance.

As to Claims 40 and 74. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a width between about 4 and 12 inches. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a width between about 4 and 12 inches so as to achieve the desired aesthetic appearance.

As to Claim 41. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a thickness of between about 5/16 and 3/4 inch. However, it is not

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inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a thickness of between about 5/16 and 3/4 inch so as to achieve the desired aesthetic appearance.

As to Claim 45. Caceres et al disclose at least two posts (17), each of said posts having an elongate configuration extending between an upper end and a lower end and being substantially parallel to the pickets, said posts being secured to the mounting rails, wherein the lower ends of the posts extend below the lower ends of the pickets to secure the posts in a ground location (Fig 1).

Claims 25-27, 29-33, and 68-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newberry, Jr. (US 3,801,072) in view of Gleeson et al (US Patent Application Publication 2001/0047741).

As to Claims 25, 26, 31, 68, 70, and 72. Newberry, Jr. discloses a fence picket comprising a plurality of layers of fiberglass (Col 2, Lines 59-64), wherein the picket (11) has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the picket has a pattern formed on the front surface and back surface of the picket (Col 1, Lines 35-43), the pattern being applied to the front surface and to the back surface of the picket

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substantially simultaneously and the picket being made desired shape for use in the fence system prior to curing (Col 1, Lines 35-43),

the picket is secured to a the mounting surface (30) by a fastener passing through the front surface and the back surface of the individual member (Col 4, Lines 27-30) and into the mounting surface (30), and

the picket having at least one surface that has a pre-finish thereon resembling a wooden picket (Col 1, Lines 29-43); said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1; Col 3, Lines 61-64).

It is noted that the limitation of "the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed when the features are present. See MPEP § 2113.

Newberry Jr. does not disclose the pickets being made of fiber cement whereby the plurality of individual members do not exhibit any substantial fraying of the fibers along surfaces of the pickets after curing, wherein the fiber cement forming the pickets incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the pickets as taught by Newberry to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As to Claims 69 and 75. Newberry Jr. discloses the upper end of at least one individual member being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1—Shows the pickets with a dog-eared shape).

As to Claims 27, 32 and 76-78. Newberry Jr. discloses the front surface and back surface of at least one individual member having a first surface, wherein the first surface

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has a finish that is capable of resembling wood or the color thereof or masonry (Col 1, Lines 39-43).

As to Claims 29 and 30. Newberry Jr. discloses at least one exterior surface of the picket being stained or being textured (Col 1, Lines 39-43).

As to Claim 33. Newberry Jr. discloses the picket capable of being nailed onto a fence rail (Col 4, Lines 27-30).

As to Claims 71, and 73. Newberry Jr. discloses a fence system wherein each of said pickets has a length between about 6 and 8 feet (Col 2, Lines 5-7).

As to Claim 74. Newberry Jr. does not disclose a fence system wherein each of said pickets has a width between about 4 and 12 inches. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a width between about 4 and 12 inches so as to achieve the desired aesthetic appearance.

***Response to Arguments***

Applicants' arguments filed 4/23/2007 with respect to claims 1-7, 9-15, 25-27, 29-37, 39-45, and 68-78 have been fully considered but they are not persuasive.

As to the rejection of the claims in view of Caceres and Gleeson, Applicants argue:

*"Applicants respectfully disagree with the Examiner's assessment of Caceres and Gleeson. At the time the invention was made, there was no motivation to use fiber cement as disclosed in Gleeson in place of the fiberglass fence panels of Caceres. First, the fiberglass materials disclosed in Caceres are vastly different from fiber cement and the materials have different qualities and characteristics. Applicants submit that one of skill in the art would not have been motivated to switch the fiberglass material of Caceres with the fiber cement composition of Gleeson for use in a fencing system." (Page 9)*

Examiner respectfully disagrees. In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence* preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. Motivation for combining the teachings of the various references need not be explicitly found in the references themselves, In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)). Regardless of the fact that fiber cement and fiberglass have different qualities and characteristics,

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Gleeson explicitly and clearly teaches that fiber cement can be used in fencing applications. Hence, establishing the evidence and motivation necessary to combine the two references.

Applicant further argues:

*"Moreover, it would not have been obvious to cut to size and shape Caceres' fence pickets prior to curing even if they had in fact been made of fiber cement... Caceres discloses that the fiberglass components are drawn through an oven and then cured. The fiberglass components are then cut, in the cured state, into desired lengths and shapes. There is no disclosure or suggestion to cut or shape the elongated fiberglass fence components prior to the resin being hardened."*  
*(Pages 9-10)*

Examiner respectfully disagrees and points out that the limitations regarding the cutting and shaping and sizing of the members impart limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. It is also noted, that Gleeson teaches the provision of the members being made of fiber cement, which may require different methods of forming of the members. Regardless, it is of little consequence how (or when) the members are sized and shaped when all claimed structure is present. See MPEP § 2113.

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Applicant further argues:

*"there would be no reasonable expectation of success in making the Caceres-Gleeson combination...It is generally known that when cutting cured fiber cement materials, the side surfaces of the fiber cement that have been exposed to the cutting device may typically exhibit damage... Given that these types of damage detract from the appearance of the fiber cement product, one of skill in the art would not have considered fiber cement to have an "aesthetically pleasing or smooth appearance" as contemplated in Caceres (see Caceres, Col. 3, lines 21-28)." (Page 10).*

Examiner respectfully disagrees. The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Gleeson expressly recognizes in Par. 107, Lines 1-5 that there is an advantage to using a fiber cement material in fencing. It is again noted that the limitations regarding the cutting and shaping and sizing of the members impart limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited.

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As to the rejection of the claims in view of Newberry and Gleeson, Applicants argue:

*"Not only does Newberry not disclose or suggest using individual pickets, Newberry does not disclose or suggest using pickets 'comprising fiber cement' and 'made into a desired shape for use as a picket prior to curing of said fiber cement, whereby the picket does not exhibit any substantial fraying of the fibers along the front surface, the back surface and the side surfaces after curing'"*

*(Page 11)*

Examiner respectfully disagrees and points out that the Examiner considers each panel to be a picket in that it is a fence portion mounted on a rail between vertical posts this is proper since there are no other structural limitations in the claim limiting what the picket defines. Also, the Examiner respectfully points out that Gleeson is used in this case as the teaching reference to teach that fiber cement can be used in fencing application and that Examiner admits that Newberry does not disclose pickets comprising fiber cement. It is Gleeson, however, that teaches the deficiencies of the Newberry reference as explained in the rejection above. Again, the limitations regarding the cutting and shaping and sizing of the members impart limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited.

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Applicant further argues:

*"neither reference discloses... 'a pattern formed on the front surface and back surface of the picket, the pattern being applied to the front surface and back surface of the picket substantially simultaneously by two embossing rollers.' "*

*(Page 12)*

Examiner respectfully disagrees because, as advanced above, the limitation of "the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" imparts limited patentable weight to the invention because this is a process recitation within a product claim and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed when the features are present. See MPEP § 2113.

Applicant finally argues:

*"Newberry's molded fence would not even be based on fences with spaced-apart pickets in that 'care must be exercised in selecting materials for the model panel. If the panel is a wood fence, the staves must be selected for a relative close fit"... Newberry cautions that the 'junctions between the individual components [of the to-be-modeled fence] should be relatively continuous' (Pages 12-13)*

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Examiner respectfully disagrees. It is unclear how ½ inch between pickets would not be considered a "relatively close fit" as taught by Newberry. That being said, merely because Newberry cautions for a relatively close fit does not preclude the pickets from being spaced apart ½ to 1 inch. This is a suggestion by Newberry and does not limit the arrangement whatsoever.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTK

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4/30/2007



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